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OFFICE OF PETITIONS

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1001 G Street N.W.,
Washington, DC 20001-4597

In re Application of
Farley et al.
Application No. 09/694,789
Patent No.: 6,787,574
Filed: October 20, 2000
Attorney Docket No. 005242.87031

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: DECISION GRANTING APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This decision is in response to Applicants' "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" timely filed on August 11, 2003 and renewed on September 27, 2004 requesting that the Office adjust the PAIR calculation to be 63 days at the time of the mailing of the notice of allowance and to be 332 days at the time of the issuance of the patent.

APPLICANTS' application for PTA is **granted to the extent herein indicated**. The Office will adjust the PAIR calculation to reflect a determination of 331 days at the time of the issuance of the patent. The Office will also *sua sponte* issue a certificate of correction reflecting the correct amount of PTA at the time of the issuance of the patent, three hundred and thirty-one (331) days.

Applicants disputing this decision have two months to file a response. No extensions of time are granted under 37 CFR 1.136.

Applicants assert that the Office was correct in determining the amount of Office delay pursuant to 37 CFR 1.702(a)(1), a sixty-three day Office delay. In addition, the applicant believes that the amount of Office delay for failing to issue the application within four months of the payment of the issue fee and all other requirements being satisfied pursuant to 37 CFR 1.702(a)(4) is two hundred and sixty-nine (269) days. Applicants dispute the reduction under 37 CFR 1.704(b) for an overdue response to the notice to file missing parts, a thirty-six (36) day delay. In addition, applicants dispute the 120 day delay under 37 CFR 1.704(c)(10).

Applicants' assessment of the PTA determination is correct to an extent herein indicated. Applicants' assertion as to the Office's requirement to issue the application within four months of the payment of the issue fee and other requirements being satisfied is inaccurate by one day. The correct amount of Office delay for failing to issue the application within four months of the payment of the issue fee and other requirements being satisfied is 268 days as PAIR calculated.¹ Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application. Applicants' response to the Office's notice to file missing parts was filed on February 16, 2001, not April 16, 2001 as noted in PALM. Accordingly, applicants response was within three

¹The delay began on December 14, 2003, the day after four month date of payment of issue fee and ended on September 7, 2004, day that the patent issued, an overall 268 day delay.

months of the mailing of the notice to file missing parts.² Therefore, the thirty-six days of delay assessed by the Office is in error. In addition, applicant did not submit any paper after the mail date of the notice of allowance that is considered a failure to engage pursuant to 37 CFR 1.704(c)(10). The Office assessed a one hundred and twenty day delay for a paper submitted on August 13, 2003. However, upon review, the "miscellaneous incoming letter" submitted on such date is actually the PTA petition. The submission of an application for Patent Term Adjustment pursuant to 37 CFR 1.705(b) is not considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(10). See 37 CFR 1.704(e). Accordingly, the one hundred and twenty day reduction is an error. Overall, the actual amount of PTA at the time of the issuance of the patent is 331 days.

After the mailing of this decision, the file will be forwarded to the certificate of correction branch for a prompt issuance of a certificate of correction.

The Office has assessed the \$200.00 fee for the submission of the petition. No additional fees are required.

Any questions concerning this decision should be directed to KeryA. Fries, at 571-272-7757.



Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: draft certificate of correction
Adjusted PAIR calculation

²The Office notes that applicants are given three months to reply to the notice without loss of PTA regardless of the shortened statutory period set by the Office.